

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

015358-007400US

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EFS-Web with the United States Patent and Trademark Officeon 4/25/08Signature /Linda Shaffer/Typed or printed
name Linda Shaffer

Application Number

10/001,891

Filed

November 19, 2001

First Named Inventor

Hull, Jonathan J.

Art Unit

2178

Examiner

Manglesh M. Patel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor./Sean F. Parmenter/☐ assignee of record of the entire interest.

Signature

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
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☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

4/25/08

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☐ *Total of _____ forms are submitted.

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PATENT
Attorney Docket No.: 015358-007400US
Client Ref. No.: ID-RSV-263D

TOWNSEND and TOWNSEND and CREW LLP

By: /Linda Shaffer/
Linda Shaffer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jonathan J. Hull *et al.*

Application No.: 10/001,891

Filed: November 19, 2001

For: PAPER-BASED INTERFACE FOR
MULTIMEDIA INFORMATION
STORED BY MULTIPLE
MULTIMEDIA DOCUMENTS

Customer No.: 20350

Confirmation No. 1067

Examiner: Manglesh M. Patel

Technology Center/Art Unit: 2178

ARGUMENTS IN SUPPORT OF PRE-
APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal mailed herewith, Appellants submit the following arguments in support of the Pre-Appeal Brief Request for Review. All of the pending claims 1-28 stand finally rejected as being unpatentable, in view of U.S. Pat. No. 5,713,021 to Kondo et al. (hereinafter “Kondo”), in view of U.S. Pat. No. 7,075,671 to Kanevsky et al. (hereinafter “Kanevsky”). As set forth in detail below, in rejecting claims 1-28 under 35 U.S.C. § 103(a), the Examiner failed to establish that the subject matter sought to be patented, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

The Examiner further committed clear error in applying the framework for the objective analysis for determining obviousness under 35 U.S.C. § 103(a) as stated in Graham v.

John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). In ascertaining the differences between the claimed invention and the prior art, the Examiner's conclusion that multimedia data is analyzed because that data is retrieved via methods in Kondo. Such retrieval in Kondo is substantially different from actually analyzing multimedia information or actually analyzing printable representations of the multimedia information as recited in one or more of the pending claims.

Embodiments in accordance with the present invention relate to techniques for generating paper documents that provide a paper-based interface to multimedia information based upon a plurality of multimedia documents storing the multimedia information in electronic form. (Specification: Paragraph [15]; FIG. 7A illustrates one example of a paper-based interface that can be generated). In various embodiments, a single printable representation can include multimedia information selected from the plurality of multimedia documents based upon selection criteria. (Specification: Paragraph [211]). For example, the selection criteria may specify a particular subject (e.g., information related to the Taliban in Afghanistan, or abortion related information, etc.), a specified story line, and the like.

In various embodiments, the actual printable representations of the multimedia documents may be analyzed to identify portions of multimedia information from the various multimedia documents to be included in the consolidated printable representation. (Specification: Paragraph [215]; FIG. 14 depicting a method of generating a single printable representation by analyzing the printable representations of the plurality of multimedia documents). In further embodiments, the actual multimedia information stored by the multimedia documents may be analyzed to identify portions of the multimedia information that satisfy the selection criteria (e.g., using audio-to-text conversion, keyframe analysis techniques, facial analysis, etc.). (Specification: Paragraph [113], [215]; FIG. 15). A consolidated printable representation may then be generated to include portions of multimedia information from the various multimedia documents that satisfy the selection criteria. (Specification: Paragraph [215]).

Pending independent claim 1 accordingly recites, in part, a computer-implemented method comprising "receiving input identifying a selection criterion" and "analyzing the multimedia information stored by the plurality of multimedia documents in

response to the input to identify portions of multimedia information that satisfy the selection criterion, the identified portions of multimedia information including at least a first portion extracted from a first multimedia document from the plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents.” (Emphasis added). The portions of the multimedia information that satisfy the selection criterion may be printed, including the extracted first portion and the extracted second portion, on a paper medium to generate the paper document comprising a set of one or more printed pages. Independent claims 11, 13, and 23 generally recite similar techniques.

Pending claim 6 recites in part the features of “analyzing the printable representation for the first multimedia document in response to the input to identify at least one portion of the printable representation that satisfies the selection criterion” and “analyzing the printable representation for the second multimedia document in response to the input to identify at least one portion of the printable representation that satisfies the selection criterion.” (Emphasis added). Independent claims 18 and 26 generally recite similar techniques.

All pending claims stand rejected as being unpatentable in view of Kondo and Kanevsky. However, the references relied upon in by the Examiner, taken individually or in combination, fail to disclose, explicitly or even impliedly, all of the claim limitations recited in the pending claims. Moreover, the references relied upon in by the Examiner, taken individually or in combination, contain substantial differences as a whole between the claim limitations recited in the pending claims.

Kondo and Kanevsky, either individually or in combination, fail to disclose the features of analyzing multimedia information stored by a plurality of multimedia documents in response to input identifying selection criteria to identify portions that satisfy the selection criteria as recited generally in each of independent claims 1, 11, 13, and 23.

In contrast to the pending claims, Kondo discloses a multimedia data search system where the actual multimedia data is separate from “features” of the multimedia data. (See FIG. 2 of Kondo below separating multimedia data from features referred to as view objects). A user in Kondo creates a view object that includes keywords and “pointers” to the actual portions of multimedia data. Kondo further discloses that the multimedia data search

system of Kondo includes a search unit “for searching view objects” stored in the storage unit

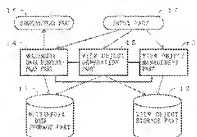


FIG. 2

according to a feature of the portion of data. (Kondo: Abstract).

Therefore, Kondo is different from the analysis of actual multimedia information/printable representations of multimedia information in response to input specifying selection criteria as recited in the pending claim. Kondo does not disclose analyzing multimedia information stored in a plurality of multimedia documents in response to selection criteria as recited in claim 1.

for example, because when a user performs a search using the system of Kondo, the search unit analyzes/searches the view objects, not the separated multimedia data, to determine whether any view objects match keywords in the input of the user. (Kondo: FIG. 5, see keyword of view object).

On page 11 of the Final Office Action dated January 15, 2008, the Examiner states that Kondo suggests analyzing multimedia information as recited in claim 1 in that multimedia information in Kondo is analyzed because the information is is retrieved via the display() and Play() methods invoked by the view object. The Examiner fails to provide any reasoning or explanation why the simple retrieval/display process in Kondo includes an analysis to identify portions of multimedia information that satisfy selection criteria as recited in claim 1. The display() and Play() methods are invoked in Kondo after a view object having the correspondence methods is matched against the user input during a search. No further identification of multimedia data would be understood to be performed in Kondo based on the user input after the view object is identified.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Examiner failed to show that any of the cited references, individually or in combination, expressly or impliedly suggest the invention recited in claim 1 because searching view objects being non-multimedia information in

Kondo does not teach or suggest analyzing multimedia information stored by a plurality of multimedia documents in response to input to identify portions of multimedia information that satisfy the selection criterion as recited in claim 1. Furthermore, the Examiner's conclusion that retrieving multimedia data based on methods in view objects searched by a user in Kondo is equivalent to analyzing multimedia information stored in a plurality of multimedia documents in response to selection criteria as recited in claim 1 lacks a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Moreover, Kondo and Kanevsky, either individually or in combination, fail to disclose analyzing a printable representation for a first and second multimedia document as generally recited in each of independent claims 6, 18, and 26. The Examiner indicates that it would have been obvious based on Kanevsky to analyze "the printed representations" based on user criteria. However, claim 6 more correctly recites, in part, analyzing a printable representation to identify a portion of the printable representation that satisfies the selection criteria. There is a substantial difference between an alleged user analysis of the printed paper representation in Kanevsky the above limitation recited in claim 6.

The Examiner has not established where the art of record discloses the above discussed features recited in the pending claims or presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. For these reasons, it is respectfully submitted that the rejection should be reversed, and a notice of allowance issued.

Respectfully submitted,

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